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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,586	01/25/2002	Toshihiro Morita	450101-02903	4193
20999	7590	08/23/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			KOROBOV, VITALI A	
			ART UNIT	PAPER NUMBER

2155

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/913,586

**Applicant(s)**

MORITA ET AL.

**Examiner**

Vitali Korobov

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/11/01, 8/15/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This is a first Office Action on the merits of this application. Claims 1-42 are presented for examination, of which claims 1-16 were cancelled by a preliminary amendment. Claims 17-42 are pending in this office action.

#### *Paper Submitted*

2. It is hereby acknowledged that the following papers have been received and placed of record in the file: **Information Disclosure Statements** as received on 8/15/2001 and 8/11/2003. Only references in the English language, or references with at least abstract in the English language were considered.

#### *Specification*

3. The disclosure is objected to because of the following informalities:

**Title:** The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

“Method and Apparatus for Information Processing, and Medium for Storing Program” is descriptive of the exceedingly broad area of technology that concerns information processing. A proper title that is more specific to the subject matter of the disclosure, i.e. electronic music distribution, is required.

**Abstract:** Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it consists of a single sentence. Appropriate correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-42 are rejected under 35 U.S.C. 112, second paragraph.

Claims 17 and 32 recite the limitation "the apparatus". There is insufficient antecedent basis for this limitation in the claim.

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Claims 17, 23 and 29 recite the limitation "the display". There is insufficient antecedent basis for this limitation in the claim.

Claims 18, 21, 24, 27, 30, 32, 37 and 41 recite the limitation "the communications". There is insufficient antecedent basis for this limitation in the claim.

All dependent claims are rejected as having the same deficiencies as the claims they depend from.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 17-42 are rejected under 35 U.S.C. 102(e) as being anticipated by the U. S. Patent 6,784,925 to Tomat et al. (hereinafter Tomat).

Regarding claim 17, Tomat teaches an information processor comprising: means for detecting that a terminal having a content stored therein is connected to the

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apparatus itself (Col. 7, lines 25-27, where the terminal is a digital camera 14, and the apparatus is a computer system 1 (see Fig. 1)); and means for automatically starting up a program which reads contents-related data from the terminal and controls the display to provide a display corresponding to the data, when the terminal is connected to the apparatus (Col. 7, lines 27- 37).

Regarding claim 18, Tomat teaches the apparatus according to claim 17, further comprising: means for detecting, when the detecting means detects that the terminal is connected to the apparatus itself (Col. 7, lines 40-42 – monitoring of the port where the camera is connected), setting information (Fig. 5, item 49 – Settings) recorded in the terminal and indicative of whether a content is to be checked out (Col. 7, lines 65-67 – display of thumbnail images that are indicative of the camera content); and means for controlling the communications with the terminal (Control panel of Fig. 13) to automatically check in a first content from the terminal (Col. 8, lines 1-2 – content images are downloaded sequentially. Control panel of Fig. 13, item 135 – option to automatically delete the files (check in) after they have been downloaded) and check out a second content stored in the apparatus itself to the terminal (Control panel of Fig. 13, item 126 – option for content check out to the CameraGear Canisters), on the basis of the setting information in the terminal when the detecting means detects that the terminal is connected to the apparatus itself (Setting on Control panel of Fig. 13).

Regarding claim 19, Tomat teaches the apparatus according to claim 17, wherein: the detecting means detects that a recording medium having contents recorded therein is connected to the apparatus itself (Col. 7, lines 28-32); and the start-up means starts up the program which automatically reads contents-related data from

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the recording medium (Col. 7, lines 28-32) and controls the display to provide a display corresponding to the data (Col. 7, lines 65-67 – display of thumbnail images that are indicative of the camera content), when the recording medium having contents recorded therein is connected to the information processor (Col. 7, lines 58-67).

Regarding claim 20, Tomat teaches the apparatus according to claim 17, wherein the start-up means automatically starts up the program which controls to display an artist name and a music title of the content based on the data (Col. 6, lines 14-15 – storage of digital sound files in the camera. Col. 11, lines 17-26 – user control over naming the files. Also, fig. 13, Options area 124).

Regarding claim 21, Tomat teaches the apparatus according to claim 17, further comprising: means for setting whether a content is to be automatically checked out to the terminal (Fig. 13, item 126)); means for detecting that a terminal having a first content stored therein is connected to the information processor (Col. 7, lines 25-27, where the terminal is a digital camera 14, and the apparatus is a computer system 1 (see Fig. 1)); and means for controlling the communications (Control panel of Fig. 13) with the terminal to automatically check in the first content from the terminal (Col. 8, lines 1-2 – content images are downloaded sequentially. Control panel of Fig. 13, item 135 – option to automatically delete the files (check in) after they have been downloaded) and check out a second content stored in the apparatus itself to the terminal (Control panel of Fig. 13, item 126 – option for content check out to the CameraGear Canisters), on the basis of the setting in the setting means when the detecting means detects that the terminal is connected to the apparatus itself (Setting on Control panel of Fig. 13).

Regarding claim 22, Tomat teaches the apparatus according to claim 21, further comprising: means for controlling a display to display a list of data related to the second content which has been automatically checked out (Fig. 22 – listing of files).

Claims 23-28 are rejected in view of the above rejection of claims 17-22. Claims 23-28 are essentially the same as claims 17-22, except that claims 23-28 set forth the invention as a method rather than an apparatus, as do claims 17-22.

Claims 29-31 do not teach or define any new limitations above claims 17-22, except they set forth the invention as a program storage medium, rather than an apparatus, as do claims 17-22. Therefore, claims 29-31 are rejected under the same rationale as claims 17-22.

Regarding claim 32, Tomat teaches an information processor comprising: means for setting whether a content is to automatically be checked out to a terminal connected to the apparatus itself (Fig. 13, item 118. User may be prompted for file download, or file download can proceed automatically, as per col. 2, lines 32-40); means for detecting that a terminal having a first content stored therein is connected to the apparatus itself (Col. 7, lines 25-29); and means for controlling the communications with the terminal (Control panel of Fig. 13) to automatically check in a first content from the terminal (Col. 8, lines 1-2– content images are downloaded sequentially. Control panel of Fig. 13, item 135 – option to automatically delete the files (check in) after they have been downloaded) and to check out a second content stored in the apparatus itself to the terminal (Control panel of Fig. 13, item 126 – option for content check out to the CameraGear Canisters), on the basis of a setting made by the setting means when the setting means detects that the terminal is connected to the apparatus (Setting on Control panel of Fig. 13).



Regarding claim 33, Tomat teaches the apparatus according to claim 32, further comprising means for detecting, when the detecting means detects that the terminal is connected to the apparatus (Col. 7, lines 25-29), setting information recorded in the terminal (Fig. 5, item 49 – Settings) and indicative of whether a content is to automatically be checked out (Col. 7, lines 65-67 – display of thumbnail images that are indicative of the camera content); when the detecting means detects that the terminal is connected to the apparatus, the communications controlling means (Control panel of Fig. 13), controlling the communications with the terminal to automatically check in a first content from the terminal (Fig. 13, item 135) and check out a second content recorded in the apparatus itself to the terminal on the basis of the setting information in the terminal (Fig. 13, item 126).

Regarding claim 34, Tomat teaches the apparatus according to claim 32, further comprising means for a filter setting information detecting means for detecting filtering data intended for use to select a desired content recorded in the terminal when the detecting means detects that the terminal is connected to the apparatus (Fig. 13, controls corresponding to the items 127 – “Custom Save”); when the detecting means detects that the terminal is connected to the apparatus, the communications controlling means controlling the communications with the terminal to automatically check in the first content from the terminal (Fig. 13, item 153) and check out the second content recorded in the apparatus itself to the terminal on the basis of the filter setting information in the terminal (Fig. 13, item 126).

Regarding claim 35, Tomat teaches the apparatus according to claim 32, further comprising a filter setting information detecting means for detecting filtering data intended for use to select a desired content (Fig. 13, controls corresponding to the items 127 – “Custom Save”); when the detecting means detects that the terminal is connected

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to the apparatus, the communications controlling means controlling the communications with the terminal to automatically check in the first content from the terminal (Col. 8, lines 1-2— content images are downloaded sequentially. Control panel of Fig. 13, item 135 – option to automatically delete the files (check in) after they have been downloaded) and check out the second content recorded in the apparatus itself to the terminal on the basis of the filtering data (Fig. 13, item 126).

Regarding claim 36, Tomat teaches the apparatus according to claim 35, wherein the filtering data is decided to select a content at a high rank in a hit chart (Col. 12, lines 31-43 – selection means for downloading files from the Internet).

Claims 37-40 are rejected in view of the above rejection of claims 32-36. Claims 37-40 are essentially the same as claims 32-36, except that claims 37-40 set forth the invention as a method rather than an apparatus, as do claims 32-36.

Claims 41-42 do not teach or define any new limitations above claims 32-36, except they set forth the invention as a program storage medium, rather than an apparatus, as do claims 32-36. Therefore, claims 41-42 are rejected under the same rationale as claims 32-36.

**Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection

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of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vitali Korobov  
Examiner  
Art Unit 2155

08/18/2005  
VAK

  
**BHARAT BAROT**  
**PRIMARY EXAMINER**